

REMARKS

The present Amendment After Final responds to the final Office Action dated August 11, 2005 having a shortened statutory period for response set to expire November 11, 2005. Filed concurrently herewith is a request for a three (3) month extension of time to respond, making the present Amendment After Final due by February 11, 2006, which is a Saturday, such that the present submission is timely if filed on Monday, February 13, 2006. Also filed herewith is a Notice of Appeal and a Terminal Disclaimer along with the respective associated fees.

In the final Office Action, claims 1-7 were pending and each claim has been rejected under 35 U.S.C. § 112, first paragraph. The claims have also been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-18 of U.S. Patent No. 6,410,480. Although Applicants do not concede the Examiner's position with regard to the double patenting rejection, the Examiner will note that the present Amendment After Final is accompanied by a Terminal Disclaimer, form PTO/SB/26, based on common ownership, to remove the double patenting rejection and expedite allowance of this case. A Terminal Disclaimer fee pursuant to 37 CFR 1.20(d) is also included.

The only outstanding issue remaining, then, is the rejection of the claims under 35 U.S.C. § 112, first paragraph. Applicants respectfully disagree with the Examiner's rejection and request reconsideration of the rejection in view of the arguments set forth below. First, Applicants' take the position that the Examiner has not set forth a *prima facie* case that the claimed invention is not properly enabled. Applicants further submit that the specification, along with the five (5) Declarations submitted pursuant to 37 C.F.R. § 1.132, clearly and adequately enable one ordinary skilled in the art how to make and how to use the invention claimed.

Applicants first assert that the Examiner has not set forth sufficient reason to shift her initial burden to provide a reasonable basis upon which to question the enablement provided for the claimed invention. "In examining a patent application, the P.T.O. is required to assume that the specification complies with the enablement provision of Section 112 unless it has 'acceptable evidence or reasoning to suggest otherwise.... The P.T.O. thus must provide reasons supported by the record as a whole why the specification is not enabling... *Then and only then* does the burden shift to the applicant to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation." 3 Chisum, Patents § 7.03[8][a] p. 7-145 -7-146, footnote 5 (citing Gould v. Mossinghoff, 229 USPQ 1, 13-14 (D. D.C. 1985), *aff'd in part, vacated in part, and remanded sub nom.* Gould v. Quigg, 822 F.2d 1074, 3 USPQ2d 1302 (Fed. Cir. 1987)) (2002). (emphasis added). Additionally, declarations submitted after the filing date, which demonstrates the herbicidal action of the claimed invention should also be considered. See MPEP § 2164.05.

In the final Office Action, the Examiner takes the position that “[t]he claim(s) contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” (final OA, p. 2). Importantly of note is the reason for which the Examiner takes this position, which is located on pages 2 and 3 of the final Office Action as follows:

“Following reasons apply: The compounds represented by the formula (I) in claim 1 contain thousands of compounds, the combination”

(final OA, p. 2-3). Applicants believe that the Examiner intended to elaborate on her statement here. However, the reasoning remains incomplete and is therefore confusing. Applicants respectfully request that the Examiner provide further explanation as to her position to give Applicants a full opportunity to respond to the rejection.

In further support of the enablement rejection, the Examiner identifies five (5) factors considered relevant to Applicants claims. However, Applicants respectfully submit that in describing these five (5) factors, the Examiner concludes with only a general and unsupported allegation to support the rejection, which is perhaps best representative by the following statement: “Since the claims are broad and there is not sufficient guidance presented in the Specification for such a large class of compounds, one skilled in the art would go through undue experimentation to practice the invention as claimed.” (final OA, p. 8). Applicants respectfully submit that such an unsupported general allegation, without more, does not satisfy the Examiner’s initial burden of presenting by a *preponderance of evidence* why one skilled in the art would not be able to make and use the invention as claimed. Accordingly, the burden has not shifted to Applicants to demonstrate that the disclosure is enabling for the subject matter of each of the pending claims and the rejection is improper.

Notwithstanding the foregoing, Applicants submit that the present specification complies with 35 U.S.C § 112, first paragraph because it is sufficient to inform those skilled in the art how to both make and use the claimed invention without undue experimentation. Applicants’ position is further bolstered by the five (5) 1.132 Declarations submitted in response to the Office Action of February 23, 2005.

A. Applicants’ specification enables one ordinarily skilled in the art
How to Make the invention claimed

Applicants’ specification sufficiently describes to one ordinarily skilled in the art how to make the claimed invention. First, at a minimum, a representative selection of the compounds of formula (I) are presented in the disclosure by structure, description, and physical data. The

Examiner's attention is directed to Table 1, for example, on pages 25-30¹, which illustrates 88 different compounds of formula (I). Additionally, select compounds of formula (I) are discussed on pages 7-10. Moreover, on page 12 of the specification, reference is made to the eleventh edition of The Pesticide Manual, which is certainly a reference well known to one ordinarily skilled in the art. The Examiner's attention is drawn to the following paragraph:

If not otherwise stated, the above-mentioned components of the compound of formula I are known from The Pesticide Manual, Eleventh Edition, 1997, BCPC. The components of the compound of formula I may, if desired, also be present in the form of esters or salts, as named e.g. in The Pesticide Manual, Eleventh Edition, 1997, BCPC. Butafenacil is known from US-A-5.183.492. Pethoamid has the CAS registration number 106700-29-2. Mesotrione is known from US-A-5,006,158.

(page 12). Reference is also made to pages 14 and 25, which show different structures contemplated by the compound of formula (I), namely (Ia) (Ib) (Ic) (Id) and (Ie). Methods of making compounds of formula I are discussed on pages 15-18, with specific examples therefore on pages 19-25.

Applicants' disclosure also describes the second herbicide, which is combined with a select compound of formula (I) to form the claimed composition of the invention. The Examiner's attention is directed to, for example, pages 10-11, reference being made in some cases to the respective CAS numbers. To one skilled in the art, both the compounds of formula (I) and the second herbicides are known in the relevant literature and obtainable.

From the foregoing, one of ordinary skill in the art would clearly be able to either make or obtain the components of Applicants' claimed composition. Further, how to make the composition itself, by combining the components is also clearly described. For example, page 32 describes that the compound of formula I is present in relation to the second herbicide in a weight ratio of 1 : 100 to 1000 : 1. The addition of other components in Applicants' claimed composition is further described on pages 32-35, for example. Moreover, specific formulations are provided on pages 36-39.

B. Applicants' specification enables one ordinarily skilled in the art
How to Use the invention claimed

Applicants' disclosure teaches the ordinarily skilled person in the art how to use the claimed composition. By way of example, the Examiner's attention is directed to page 30, wherein it is contemplated that the composition can be used by treating the cultivated plants, the seeds or seedlings or the crop area thereof. It is submitted that each of these is a customary technique of controlling weeds in crops of cultivated plants such as to be well understood by one

¹ The page numbers referenced correlate to the pagination of WO 01/17351.

ordinarily skilled in the art. Further, a more detailed description is provided on pages 31, 33, 35 and 36, for example.

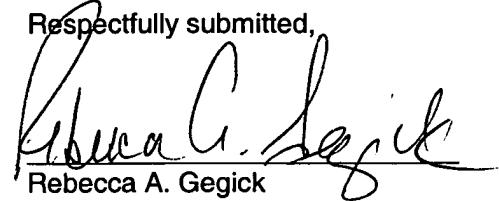
In addition to the foregoing, Applicants have at, a minimum, illustrated a representative sample of the selective herbicidal action of the claimed composition. Reference is made to pages 39-45, as well as the five (5) 1.132 Declarations submitted in response to the Office Action dated February 23, 2005. Between the Examples in the specification and those provided in the Declarations, the herbicidal action of over 30 different compositions of a selected compound of formula (I) and a selected second herbicide are illustrated. Here, Applicants' have provided a sufficient number of representative examples such that one of skill in the art would expect that any select compound of formula (I) and second herbicide would be expected to perform in the same manner without undue experimentation. To argue the contrary will require more than a general allegation that Applicants' disclosure would have not taught one skilled in the art how to make and use the full scope of the claimed invention. Indeed, as provided in MPEP § 2164.03. “[p]roof of enablement will be required for other members of the claimed genus *only where adequate reasons* are advanced by the examiner to establish that a person skilled in the art could not use the genus as a whole without undue experimentation.” (MPEP § 2164.03, p. 2100-196).

C. Conclusion

Based upon the arguments articulated above, Applicants submit first that the Examiner has improperly set forth a *prima facie* case for rejecting the pending claims under 35 U.S.C. § 112, first paragraph. Again, applicants enjoy a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. See, *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). Secondly, Applicants' specification is truly enabling of the invention claimed. Applicants' have pointed out specific representative areas of the disclosure which clearly and adequately informs one of ordinary skill in the art both how to make and used the claimed invention. Accordingly, Applicants submit that the pending claims are in condition for allowance.

No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,


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